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EXAMINER

WALKE, AMANDA C

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JINKO KIMURA, CHIKARA ISHIKAWA, YOUJI TANAKA,  
SHINJI TAKANO, and YOSHITAKA MINAMI

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Appeal 2009-003250  
Application 09/508,771  
Technology Center 1700

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Decided:<sup>1</sup> June 17, 2009

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Before BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1-10, 12-19, 21-25, 27-38, and 42-46 (Final Office Action, mailed Mar. 13, 2006), the only claims pending in the application.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

#### STATEMENT OF THE CASE

Claim 1 is illustrative of the subject matter on appeal and is reproduced from the Claims Appendix to the Revised Appeal Brief ("App. Br."), filed May 4, 2007:

1. A photosensitive film which comprises a support film (A), a photosensitive resin composition-containing photosensitive resin layer (B) formed on said support film (A), and a protecting film (C) stuck onto said photosensitive resin layer (B), wherein:

the number of fish eyes having a diameter of at least 80  $\mu\text{m}$  included in said protecting film (C) does not exceed 5 fish eyes/ $\text{m}^2$  when measured under a microscope at a multiplication of 100; and

said photosensitive resin composition-containing photosensitive resin layer (B) has a film thickness of 5 to 30  $\mu\text{m}$ , and whereby

generation of air voids between the photosensitive layer (B) and a substrate after lamination of the photosensitive film on the substrate while removing the protecting film (C) from the photosensitive film is reduced.

The Examiner relies on the following evidence to establish unpatentability (Examiner's Answer ("Ans."), mailed Aug. 9, 2007):

|          |           |               |
|----------|-----------|---------------|
| Taguchi  | 4,360,582 | Nov. 23, 1982 |
| Hoffmann | 4,710,446 | Dec. 1, 1987  |
| Mannion  | 5,198,484 | Mar. 30, 1993 |

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<sup>2</sup> An oral hearing was held on June 10, 2009.

Takahashi

5,589,306

Dec. 31, 1996

Appellants request review of the following grounds of rejection (App. Br. 18):

1. claims 1-10, 13-19, 21-25, 28-38, and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Taguchi in view of Mannion;
2. claims 12 and 27 under 35 U.S.C. § 103(a) as unpatentable over Taguchi in view of Mannion and further in view of Hoffmann; and
3. claims 42 and 43 under 35 U.S.C. § 103(a) as unpatentable over Taguchi in view of Mannion and further in view of Takahashi.

#### ISSUE

Have Appellants shown reversible error in the Examiner's finding that preparation of Taguchi's protecting film in the manner taught by Mannion would inherently result in a protecting film having Appellants' claimed features?

We answer this question in the affirmative.

#### FINDINGS OF FACT ("FF")

1. The Examiner finds that Taguchi discloses a photosensitive film which includes a photosensitive resin layer, a support film and a polypropylene protecting film. (Ans. 3-4.) The Examiner concedes that "Taguchi is silent on fish eyes." (Ans. 4.)
2. The Examiner finds that Mannion discloses a method of adding clarifying agents to polyolefin resins, including polypropylene, to reduce haze in articles manufactured from the resins. (Ans. 4.) The Examiner maintains that it would have been obvious to the ordinary artisan to have prepared Taguchi's protective film by adding clarifying agents as taught by

Mannion to achieve higher transparency and better coating properties by eliminating bubbles/fish eyes. (Ans. 6.)

3. According to the Examiner, Mannion “specifically mentions that bubbles/n [sic] fish eyes are ‘eliminated’, thus the addition of the compounds to the polymers results in a number of fish eyes meeting the instant claim limitations (zero).” (Ans. 6.) The Examiner specifically relies on the “Background of the Invention” section in which Mannion discusses a prior art “approach used to eliminate bubbles or ‘fish eyes’ with sorbitol acetal clarified polyolefins . . . described by Kobayashi, et al., U.S. Pat. No. 4,954,291” (Mannion, col. 2, ll. 36-38). (Ans. 8-9 (citing Mannion, col. 2, ll. 36-47).)

4. Appellants contend that “Mannion . . . is directed solely to the elimination of ‘white point’ defects and not to the elimination of ‘fish eyes’ defects.” (Reply Brief (“Rep. Br.”), filed Oct. 9, 2007, 5 (emphasis omitted); *see also*, App. Br. 5.) According to Appellants, “white point” defects are “bubbles formed on the sides of molds by gas released during injection molding” and are “a substantially different defect than . . . ‘fish eyes.’” (App. Br. 14.)

5. Appellant’s characterization of “white point” defects is consistent with Mannion’s disclosure. (*See, e.g.*, col. 5, ll. 23-27 and col. 6, ll. 39-45.)

6. Mannion describes “[t]he present invention” as “provid[ing] a technique to process sorbitol and xylitol acetal clarifiers so they can be compounded with polyolefin resins to produce fabricated parts without ‘white points’ or bubbles” (col. 3, ll. 8-13). When discussing the problem of “‘white points’ or bubbles” (col. 2, ll. 5-6), Mannion notes that “[s]mall

bubbles in the side walls of injection molded housewares and medical devices are considered a major defect” (col. 2, ll. 7-9).

7. In Example 4, Mannion conducts testing of compositions prepared in accordance with the disclosed method for the purpose of assessing bubble formation. Mannion states only that a visual analysis was conducted (col. 9, ll. 8-9).

8. The term “fish eyes” is used only once in the Mannion patent, and is used solely in connection with Kobayashi’s method. (*See, supra*, FF 3.) The Kobayshi patent is not identified in the list of “Evidence Relied Upon” by the Examiner. (*See* Ans. 2.)

9. The term “fish eye,” as used in the Specification, refers to an “unmelted or deteriorated region of the raw material which has been taken into film at the time of thermally melting the raw material and forming it into a film by kneading, extrusion, stretching or casting.” (Spec. 13:20-24.) According to the Specification, “[a] protecting film of good fish eye level which can successfully be used in th[e] invention can be produced by modifying the production method of film, for instance, in such a manner as filtering the raw material resin after thermal melting.” (Spec. 14:12-16.)

10. Mannion does not disclose a step of filtering the raw material resin. (*See generally*, Mannion in its entirety.)

#### PRINCIPLES OF LAW

“Obviousness under 35 U.S.C. § 103(a) is ultimately a legal question, based on underlying factual determinations.” *Eisai v. Teva*, 553 F.3d 1353, 1356 (Fed. Cir. 2008) (citing *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479 (Fed. Cir. 1997)). The Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie*

case of unpatentability. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

### ANALYSIS

We have carefully considered the respective positions advanced by the Examiner and the Appellants. Based on our review of the record in this appeal, we are in agreement with Appellants that the evidence fails to support the Examiner's finding that preparation of Taguchi's protecting film using Mannion's method would inherently result in a protecting film having no more than the size and quantity of fish eyes recited in the appealed claims.

Appellants argue, and the Examiner does not dispute, that white point defects originate from trapped gases (FF 4, 5), while fish eyes are created by unmelted or deteriorated regions of the raw material (FF 4, 9). While the Examiner contends that Mannion is directed to eliminating fish eyes as well as white points (Ans. 8-9), we are in agreement with Appellants that the Examiner has taken the referenced portion of Mannion out-of-context. More specifically, like Appellants, we read Mannion's disclosure as acknowledging the known prior art problem of fish eye defects, but describing a method directed solely to eliminating the trapped gases responsible for creating white point defects. (*Compare* FF 3 *with* FF 6-8.) The Examiner has not explained why a method directed to eliminating trapped gases, i.e., Mannion's method, would necessarily result in the elimination of the unmelted or deteriorated regions of raw material responsible for creating fish eyes. (*Compare* FF 9 *with* FF 10.)

### CONCLUSION

Appellants have persuasively shown that the Examiner reversibly erred in finding that preparation of Taguchi's protecting film in the manner taught by Mannion would inherently result in a protecting film having Appellants' claimed features. Because this finding is necessary to support the Examiner's obviousness determination as to all of the appealed claims, we cannot sustain any of the Examiner's rejections under 35 U.S.C. § 103(a). Therefore, the decision of the Examiner rejecting claims 1-10, 12-19, 21-25, 27-38, and 42-46 is reversed.

### REVERSED

PL Initial:  
sld

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